



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,219	11/12/2003	Bindu Rama Rao	14321US03	6320
23446 7590 12/13/2007 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER KENDALL, CHUCK O	
			ART UNIT 2192	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,219

Applicant(s)

RAO, BINDU RAMA

Examiner

Chuck O. Kendall

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to application filed 10/02/07.
2. Claims 1 - 23 were previously presented. Claims 24 – 29 have been added and have also been considered .

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 - 3, 5 -17, and 20 – 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson et al. (US Patent 5,418,837) in view of Bartel et al. USPN 6,754,895.

Claim 1:

Johansson discloses an updatable electronic device including:

a memory including at least one of firmware and software (e.g. see Fig. 1A, items 15, and associated text);

at least one firmware component, functioning to update at least a portion of at least one of firmware and software ("the routine then changes all the software in the mobile terminal...", col. 7, lines 13 – 16, Fig. 3);

an interface for communicatively coupling to a removable electronic memory device (e.g. see Fig. 1A, item 20, and associated text);

and wherein the removable electronic memory device comprises information related to the updating of the at least a portion of the at least one of firmware and software (Fig. 1A, item 22, and associated text).

Johansson doesn't expressly disclose wherein using update information stored in the memory. However, Bartel discloses that " The update information can be distributed as a hidden application within new ROM or firmware update..." (3:22 – 25).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Johansson and Bartel, because it would enable updating the firmware transparently (Bartel, 3:25 – 30).

Claim 2:

Johansson discloses the device of claim 1 where the at least one firmware component comprises: an update agent for updating the at least a portion of the at least one of firmware and software, the update agent using the update information and the information related to the updating of the at least one of firmware and software ("the routine then changes all the software in the mobile terminal from information provided in

the upgrading software stored in the SUM card", col. 7, lines 13-16, Fig. 3, and associated text);

Claim 3:

Johansson discloses the device of claim 1 further including: a communication interface for receiving the update information (Fig. 1A, item 20, and associated text).

Claim 4:

Johansson discloses the device of claim 3 but does not disclose where the communication interface is a wireless communication interface. In an analogous art of updating mobile phones, Bartel discloses in an analogous art and similar configuration discloses "...the PID 12 is communicatively coupled to a second PID 14. PID 12 includes a wireless port, or transceiver, 16 (used herein to mean some combination of a receiver and/or transmitter). The PID 14 has a corresponding wireless port, or transceiver, 18 such that a wireless link 20 is established between the PID of 14 and PID 12.." (5:5 – 10).

It would have been obvious to one with ordinary skill in the art at the time of the invention to wirelessly update the device as claimed in order to ensure timely updates through the air as suggested by Bartel above.

Claim 5:

Johansson discloses the device of claim 2 where the update information comprises an update package containing a set of instructions executable by the update agent for updating the at least a portion of the at least one firmware and software ("upgrading data" may be stored in the SUM card, col. 4, lines 7-14, e.g. see Fig. 213, and associated text).

Claim 6:

Johansson discloses the device of claim 1 where the information related to the updating of the at least one firmware and software comprises at least one of a cyclic redundancy check (CRC), a location in a file system, a memory address, a status flag, and new firmware ("identification data telling ... if the SUM card is designed for upgrading software, adding new features... ", col. 4, line 3-6, e.g. see Fig. 3, step 110, and associated text).

Claim 7:

Johansson discloses the device of claim 1 where the information related to the updating of the at least one firmware and software comprises an indication of the availability of update information for the at least one of a firmware and software (e.g. see Fig. 3, and associated text, col. 7, lines 6-7 states "if the SUM card is valid for upgrading, the upgrading functions would be displayed on the display...").

Claim 8:

Johansson discloses the device of claim 1 where the information related to the updating of the at least one firmware and software comprises an indication of the success of an update of the at least one of firmware and software (Fig. 3, item 120).

Claim 9:

Johansson discloses the device of claim 1 where the information related to the updating of the at least one firmware and software is used to verify or authenticate an update of the at least one of firmware and software ("check that correct data is transferred ... with the data stored in the SUM memory", col. 5, lines 35-39).

Claim 10:

Johansson discloses the device of claim 1 where the removable electronic memory device comprises one of a subscriber identity module (SIM) card, a smart card, an integrated circuit (IC) card, a removable memory card, and a removable memory module (Fig. 1A, item 22).

Claim 11:

Johansson discloses a method of updating an updatable electronic device including a memory containing at least one of firmware and software, and a user removable electronic memory device (Abstract), the method including:

retrieving information from the user removable electronic memory device
("upgrading functions would be displayed", col.7, lines 7- 8);

determining whether update information for updating the at least one of firmware
and software is available ("if the SUM card is valid for upgrading", col. 7, lines 7 - 8);

and refraining from performing an update of at least a portion of the at least one
of firmware and software, if an update information for updating the at least one of
firmware and software is not available in the memory ("activates normal GSM network
activities", col. 6, lines 47 – 48).

Johansson doesn't expressly disclose wherein using update information and
performing an update of at least a portion of the at least one of firmware and software
using at least information from the user removable electronic memory device, if update
information for updating the at least one of the firmware is available in the memory.

However, Bartel discloses that, " The update information can be distributed as
a hidden application within new ROM or firmware update..." (3:22 – 25).

Therefore it would have been obvious to one of ordinary skill in the art at the time
the invention was made to combine Johansson and Bartel, because it would enable
updating the firmware transparently (Bartel, 3:25 – 30).

Claim 12:

Johansson discloses the method of claim 11 where the user removable electronic memory device comprises one of a subscriber identity module (SIM) card, a smart card, an integrated circuit card, a removable memory card, and a removable memory module (Fig. 1A, item 22).

Claim 13:

Johansson discloses the method of claim 11 where the updatable electronic device is a mobile handset (Fig. 1A).

Claim 14:

Johansson discloses the method of claim 11 where the information from the user removable electronic memory device comprises at least one of a signature, a location in a file system, a memory address,, a status flag, and new firmware ("identification data telling ... if the SUM card is designed for upgrading software, adding new features... ", col..4, line 3 – 6).

Claim 15:

Johansson discloses the method of claim 14 where the signature comprises a cyclic redundancy check (CRC) ("checksum or check data area", col. 4, line 8).

Claim 16:

Johansson discloses the method of claim 11 where the information from the user removable electronic memory device comprises an indication of the availability of update information for updating the at least a portion of the at least one of a firmware and software ("identification data telling ... if the SUM card is designed for upgrading software, adding new features... ", col. 4, line 3-6).

Claim 17:

Johansson discloses the method of claim 11 where the information from the user removable electronic memory device is used to verify or authenticate an update of the at least a portion of the at least one of a firmware and software ("check that correct data is transferred ... with the data stored in the SUM memory", col. 5, lines 35 - 39).

Claims 18 -19:

Johansson discloses the method of claim 11 but he does not disclose receiving an update package from a server; and the receiving update information comprising an update package from a server, performed using a wireless network; and the information from the user removable electronic memory device comprises the location of at least one of the update package and the server.

In an analogous and similar configuration, discloses that "PID 12 can receive the update application from, for example, the device manufacturer's centralized server" (7:20 - 25). Therefore, It would have been obvious, to one with ordinary skill in the art at the time the invention was made to combine Johansson and Bartel because, it would enable updating the device over a server.

Claim 20:

Johansson discloses the method of claim 11 further including: storing status information in the user removable electronic memory device, if an update was performed; and refraining from storing status information in the user removable electronic memory device, if an update was not performed ("data area that can be altered during or after a complete upgrading procedure", col. 4, lines 9 -14).

Claim 21:

Johansson discloses the method of claim 11 further including: performing at least one of restarting or rebooting the updatable electronic device ("re sets the telephone", col. 6, lines 54-56).

Claim 22:

Johansson discloses the method of claim 21 where at least one of a need to restart or reboot and a type of reboot is resident in the user removable electronic memory device ("If the card installed is not valid ... re sets the telephone", col. 6, lines 52-56).

Claim 23:

Johansson discloses the method of claim 11 where the determining comprises:

verifying whether the retrieved information is at least one of appropriate and authentic ("check that correct data is transferred ... ", col. 5, lines 35 -39);

continuing the performance of an update, if the verification is successful; and

executing a normal startup of the updatable electronic device, if the verification is not successful ("activates normal GSM network activities", col. 6, lines 47-48).

Claim 24 and 27:

The updatable electronic device of claim 1, wherein the update information comprises at least one update package (2:35 – 40, see upgrade software).

Claim 25:

The updatable electronic device of claim 1, wherein the information related to the updating of the at least one of firmware and software comprises information identifying the source of the update information received by the electronic device (5:35 – 40).

6. Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson et al. (US Patent 5,418,837) in view of Bartel et al. USPN 6,754,895 as applied in claims 11 and 25 and in view of Rasmussen USPN 6,640,334 B1.

Regarding claim Claims 26 Johansson as modified discloses all the claimed limitations as applied in claims 25 above. The combination of Johansson and Bartel doesn't expressly disclose the updatable electronic device of claim 25, wherein the information identifying the source of the update information comprises a universal resource locator (URL). However, Rasmussen in an analogous art and similar configuration of updating firmware of a communication device (see abstract and title) discloses that, "Downloading updated software (e.g. through the Internet) is commonly used as a means of distributing software updates" (3:2 – 25) and it is recognized in the art to use URL for downloading through internet protocol in the art.

Chuck Kendall 12/6/07